

REMARKS

Reconsideration of the present application is respectfully requested.

Indication that claims 13-28 are allowed and the allowability of claims 31-38 if rewritten is greatly appreciated.

The rejection of claims 12 and 29 under 35 USC 102(b) as being anticipated by Phan et al. is moot in view of the amendments to those claims. In particular, claim 12 is amended to now refer to allowed claim 13. Claim 29 is canceled.

The rejection of claim 30 under 35 USC 103(a) as being unpatentable over Phan et al. in view of Serrano et al. is respectfully traversed.

To support an obvious rejection like the one in this case, it is insufficient that the prior art disclosed the components of the patented device, either singularly or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. See Northern Telecom Inc. v. Datapoint Corp., 15 USPQ2d 1321 (Fed. Cir. 1990). The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id.

The Office Action makes this statement to support the obvious rejection, "It would be obvious to one of ordinary skill in the art at the time the invention was made to improve upon seek control of Phan by applying the teaching of reducing drive current when the amplifier is in saturation as taught by Serrano for the purpose as stated in column 2, lines 44 – column 3, ln. 45." This means that one skilled in the art would modify Phan with the discussed teaching of

Serrano, such modification being based on the disclosed purpose in Serrano. That statement, however, fails to support this rejection.

Nowhere in Serrano, particularly that citation to cols. 2-3, is the combination of the Serrano "saturation" invention with the Phan "filter" disclosure explicitly taught or suggested. Specifically, Serrano nowhere explicitly teaches or suggests any filtering of the motor signal used in conjunction with the "saturation" invention, much less teaching or suggesting any filtering of the motor signal.

Without that explicit teaching or suggestion, the Office Action may show some suggestion or teaching explicitly either from the knowledge of one of ordinary skill in the art combined with the teachings of the applied references or the nature of the problem to be solved. Yet the Office Action neither provides any evidence that knowledge of a skilled artisan combined with the teachings of the applied references nor that the nature of the problem to be solved by the present invention would render obvious to the skilled artisan the features of claim 30.

Without that explicit teaching or suggestion, or evidence described above, the Office Action can still support this obvious rejection by providing evidence that the prior art as a whole implicitly shows the features of claim 30. The test for an implicit showing, as stated above, is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. But the Office Action has provided no evidence that Phan, Serrano, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved (of claim 30) as a whole would have suggested to the skilled artisan the features of claim 30. Without that evidence, the Office Action statement quoted above is merely conclusory. Yet broad conclusory statements standing alone are not "evidence." See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

In conclusion, the Office Action has not shown any explicit teaching or suggestion, or relevant evidence to support the obvious rejection for claim 30. As a consequence, claim 30 is not obvious and is therefore allowable. Claims 31-38 are also allowable due to their dependency on allowable claim 30.

Conclusion

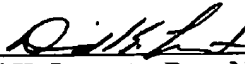
This Reply is believed to be responsive to all points raised in the Office action. Accordingly, prompt allowance and passage of the application to issue are earnestly solicited. Should the Examiner have any remaining questions or concerns, he/she is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

SEAGATE TECHNOLOGY LLC
(Assignee of Entire Interest)

Date

2/25/05


David K. Lucente, Reg. No. 36,202
SEAGATE TECHNOLOGY LLC
Intellectual Property Dept. – COL2LGL
389 Disc Drive
Longmont, Colorado 80503
(720) 684-2295 (telephone)
(720) 684-2588 (facsimile)